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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,283	09/28/2001	James Morrow	10407/521	6806
30076	7590	09/20/2006		
BROWN RAYSMAN MILLSTEIN FELDER & STEINER, LLP 1880 CENTURY PARK EAST 12TH FLOOR LOS ANGELES, CA 90067			EXAMINER PANDYA, SUNIT	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/967,283	<b>Applicant(s)</b> MORROW ET AL.	
	<b>Examiner</b> Sunit Pandya	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-45 and 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-45, 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30, 38 & 48 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contains subject matter that is in contradiction with the specification. The specification describes standalone machine that essentially be powered up and subsequently operate independently of any other system or network. However the claim contains subject matter related to a remote network to reconfigure the three displays. It does appear possible that a standalone gaming machine can be remotely reconfigured. To be remotely reconfigured, the gaming machine must be connected to the network – in which case they are no longer “standalone”.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell (US Patent No. 5,393,057) in view of Giobbi (of record).

Claims 30, 38, and 48: Marnell discloses a stand-alone gaming machine (col. 9:42-48), which includes multiple displays/screens displaying video content for a game of chance (col. 4: 17-29), as well as a display for displaying the jackpot or potential winning payout (figure 3, element 49b, which is a display connected to the processor to display the proportion of the amount to be paid out). Marnell also discloses video content comprising artwork representative of a theme of game played (col. 4: 10-29, wherein the game of poker is played and the artwork related to poker such as cards, are displayed on the display).

However, Marnell is silent on the automatic reconfiguration happening in response to a trigger and also regarding third display devices. Giobbi teaches a gaming system in which video content is capable of being reconfigured in response to various triggers such as time, play frequency (0050), wagered amount (0041& 0050) etc. Giobbi discloses a primary screen/display displaying a game being played by a player and an additional screen/display displaying a secondary game play features (0043) or any additional gaming information related to the play of the game (i.e. pay tables, winning payouts etc.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the feature of automatically reconfiguring the video content in response to a trigger as cited above as taught by Giobbi into the Marnell type system in order to provide automatic operation of reconfiguring display of subsequent gaming sessions, to allow to change the game/theme of the current game

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to a brand new game without having to replace the machine, thus reducing cost for the gambling facility.

Claims 31-34 and 39-42: Marnell discloses a stand-alone gaming machine (col. 9:42-48), which includes multiple displays/screens displaying video content for a game of chance (col. 4: 17-29), as well as a display for displaying the jackpot or potential winning payout (figure 3, element 49b, which is a display connected to the processor to display the proportion of the amount to be paid out). Marnell also discloses video content comprising artwork representative of a theme of game played (col. 4: 10-29, wherein the game of poker is played and the artwork related to poker such as cards, are displayed on the display).

However, Marnell is silent on the automatic reconfiguration happening in response to a trigger. Giobbi teaches a gaming system in which video content is capable of being reconfigured in response to various triggers such as time, play frequency (0050), wagered amount (0041& 0050) etc. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the feature of automatically reconfiguring the video content in response to a trigger as cited above as taught by Giobbi into the Marnell type system in order to provide automatic operation of subsequent gaming sessions, which would attract more players and enable use of the system without having to rely on some type of network communication interface, as well as to allow to change the game/theme of the current game to a brand new game without having to replace the machine, thus reducing cost for the gambling facility.

Claims 35-37 and 43-45: Giobbi discloses allowing casino operators and/or the players to reconfigure screen that display video content of game of chance (0050-0052). Giobbi further discloses a processor running the game and further discloses using local stored video content to provide reconfiguration to screens that display video content (0057). Giobbi also discloses a networked/centralized gaming system wherein the gaming system contains plurality of screens that display plurality of different games of chance (0009), with reconfiguring the machine in response to a reconfiguration command received from a remote location (title & 0001 & 0040).

### ***Response to Arguments***

5. Applicant's arguments filed 7/11/2006 have been fully considered but they are not persuasive.

The applicant argues that neither Marnell nor Giobbi discloses multiple display devices. The examiner respectfully disagrees with the applicant. Giobbi teaches of multiple display terminals, wherein the display terminals display the games of chance (0019, 0020, figure 1, element 12a-12n, wherein for this instant application the value for  $n = 3$ , which would enable Giobbi to disclose 3 display devices as taught in the rejection above).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Marnell reference teaches of an electronic gaming apparatus and Giobbi teaches of a centralized gaming system with modifiable displays. In this case the combination of references would teach (1) a gaming machine containing plurality of different games of chance within the machine and (2) a gaming machine connected to a network, and (3) a gaming system with multiple displays (0019, 0020), in which video content is capable of being reconfigured in response to various triggers such as time, play frequency (0050), wagered amount (0041& 0050) etc., and all of the limitations regarding the gaming machine disclosed within the applicant's claims. Therefore it would be obvious to one with ordinary skill in the art to combine the references to create a game disclosed by the claimed invention to incorporate an automatically reconfiguring the video content in response to a trigger event as taught by Giobbi into Marnell type system in order to provide automatic operation of reconfiguring displays of subsequent gaming, to attract more players.

Consequently, for the reasons provided above the rejection is maintained.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunit Pandya whose telephone number is (571) 272-2823. The examiner can normally be reached on M - F: 7:30 am - 5 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert OLSZEWSKI can be reached on (571) 272-6788. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SP

A handwritten signature in black ink, appearing to read "Corbett B. Coburn" with a stylized flourish at the end.

**CORBETT B. COBURN  
PRIMARY EXAMINER**